

From: Vohra, Sanjeev

Sent: 9/30/2021 8:50:21 AM

To: TTAB EFiling

CC:

Subject: U.S. Trademark Application Serial No. 90002764 - THE BLACK DIAMOND SERIES - N/A -
EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 90002764.doc

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 90002764

Mark: THE BLACK DIAMOND SERIES

Correspondence Address:

SHOKO NARUO

THOMPSON COBURN LLP

ONE US BANK PLAZA

ST. LOUIS, MO 63101

Applicant: Jeanette Conrad-Ellis

Reference/Docket No. N/A

Correspondence Email Address:

ipdocket@thompsoncoburn.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Jeanette Conrad-Ellis, has appealed the examining attorney's final refusal to register

the applied-for mark THE BLACK DIAMOND SERIES in standard character form under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). The examining attorney refused registration of THE BLACK DIAMOND SERIES on the Principal Register on the ground that the applicant's applied-for mark so resembles the mark THE BLACK DIAMOND EFFECT, in U.S. Registration No. 1752451, that there is a likelihood of source

confusion. This refusal is the only issue on appeal. It is respectfully requested that this refusal be affirmed.

FACTS

On June 15, 2020, applicant filed a Section 1(a), use in commerce, based application for the mark THE BLACK DIAMOND SERIES in standard characters, with a voluntary disclaimer of the term SERIES, for International Class 16 goods described as “Series of fiction books”.

In an Office Action dated August 12, 2020, the examining attorney refused Registration based on a likelihood of confusion, Section 2(d) of the Trademark Act, with U.S. Registration No. 1752451 for the mark THE BLACK DIAMOND EFFECT in standard character form for goods defined as “cartoon science fiction books and comic books” in International Class 16.

On October 6, 2020, applicant responded to the Office Action arguing against the refusal to register, as well as amending the identification of goods to “a series of fiction books for teen girls, excluding cartoon science fiction books and comic books”.

On October 28, 2020, the examining attorney issued an Office Action making Final the Section 2(d) refusal.

On February 4, 2021, applicant filed a Request for Reconsideration.

On February 27, 2021, the examining attorney issued an action denying the Request for Reconsideration.

On February 28, 2021, applicant filed a Notice of Appeal with the Trademark Trial and Appeal board along with a Request for Reconsideration after Final Action.

On May 31, 2021, the examining attorney issued an action denying the Request for Reconsideration after Final Action.

Applicant filed its brief August 1, 2021 and the appeal was forwarded to the examining attorney for brief on August 2, 2021.

OBJECTION

As a preliminary matter, the examining attorney notes that the applicant has submitted new evidence with its appeal brief. Specifically, applicant has submitted a list of third-party registrations, appended to its appeal brief and identified as Exhibit 1. Applicant's Brief, pp. 21-188. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ISSUE ON APPEAL

The sole issue on appeal is whether applicant's use of the mark THE BLACK DIAMOND SERIES in standard character form for "a series of fiction books for teen girls, excluding cartoon science fiction books and comic books" in International Class 16 creates a likelihood of confusion with the standard

character mark THE BLACK DIAMOND EFFECT in Registration No. 1752451 for “cartoon science fiction books and comic books” in International Class 16.

LIKELIHOOD OF CONFUSION ANALYSIS

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

ARGUMENT

1. THE MARKS ARE HIGHLY SIMILAR

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that

[consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Moreover, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34).

Here, applicant’s mark THE BLACK DIAMOND SERIES is confusingly similar to the registered mark THE BLACK DIAMOND EFFECT. Applicant argues that the differing wording in the marks, specifically SERIES and EFFECT, differentiates the marks and their commercial impressions, obviates any likelihood of confusion between the marks, and that the examining attorney has overlooked the differences in the marks in their entireties. The examining attorney is not persuaded by these arguments.

The marks are similar because they both contain the identical phrase BLACK DIAMOND. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom.*

Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

The applicant argues that the disclaimed term SERIES in the proposed mark should be given serious, nearly equal weight in the determination, and essentially insists on what amounts to a side-by-side comparison of the marks. However disclaimed matter that is descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Further, the dominant portion of applicant's mark is BLACK DIAMOND. While it is true that marks must be compared in their entireties, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) ("[Regarding the issue of confusion,] there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))).

Ultimately, considering the factors above, the marks are confusingly similar. It is well settled that the trademark examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

2. THE GOODS ARE HIGHLY RELATED

The second consideration revolves around the goods at issue and the channels of trade. The examining attorney contends that the goods at issue are highly related. The applicant's amended goods are "a series of fiction books for teen girls, excluding cartoon science fiction books and comic books", and the registrant's goods are "cartoon science fiction books and comic books".

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Here, applicant and registrant are both providing fiction books. Applicant's argument that the differing subject matter in the fiction books at issue diminishes their relatedness, presumably stemming from their amended identification which excludes the very type of book the registrant provides, is not persuasive. The narrowing of both the subject matter of the applicant's books and the target audience creates a minimal distinction with regard to the goods being compared. Even with the narrowing language

found in the applicant's amended identification, the applicant's fiction book goods remain related to the cartoon science fiction books and comic books goods found in the cited registration. Furthermore, regardless of the distinction in the subject matter of the books, the issue is not likelihood of confusion between particular goods and/or services, but likelihood of confusion as to the source or sponsorship of those goods and/or services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

Additionally, attached to the Final Office Action are 17 third-party registrations which show that is common for producers of fiction books to also produce and provide comic books under the same mark. October 28, 2020 Final Office Action, TSDR pp. 2-58. The evidence includes the following representative registrations:

- Registration 4298538 PINKPOWERFUL! Owned by Karen E. Melnychuck for goods including “a series of books featuring girl’s and women’s topics” and “comic books.” October 28, 2020 Final Office Action, TSDR pp. 4-6.
- Registration 4272871 MORE SURPRISES Owned by More Surprises LLC for goods including “series of fiction works, namely, novels and books” and “comic books.” October 28, 2020 Final Office Action, TSDR pp. 7-9.
- Registration 4941915 MY WATER BUDDY AND FAMILY Owned by Michele R. Wright for goods including “series of fiction books” and “comic books.” October 28, 2020 Final Office Action, TSDR pp. 17-20.
- Registration 5638274 ORPHAN BLACK Owned by Boat Rocker Rights Inc. for goods including “fiction books, nonfiction books, graphic novels, lithograph and comic books.” October 28, 2020 Final Office Action, TSDR pp. 27-29.

- Registration 6142305 STORM RAVEN Owned by Jonathan D. Morlu for goods including “printed books in the field of fiction” and “comic books.” October 28, 2020 Final Office Action, TSDR pp. 50-54.

The third-party use-based registrations highlighted above show that producers of fiction books also commonly produce and provide comic books under the same mark. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii). Further, in the absence of trade channel limitations in the goods under the registered mark, as in the case here, it may be presumed that the goods under the registered mark are offered in all customary trade channels and are available to the same class of consumers of fiction books. *Hewlett Packard Co. v. Packard Press, Inc.* 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). Thus, the goods of the parties are highly related.

3. APPLICANT’S ARGUMENTS ARE UNPERSUASIVE

Applicant argues that there is no known instance of actual confusion between the parties’ goods and that there has been no confusion during the period in which the goods have been sold. Applicant’s Brief at 13. However, “[A] showing of actual confusion is not necessary to establish a likelihood of confusion.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). “[T]he relevant test is *likelihood* of confusion, not *actual* confusion.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original).

“Uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value,” especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Thus, Applicant’s argument is unpersuasive.

Applicant argues that its goods are “marketed to distinct groups of sophisticated consumers (readers) who are not making an impulse purchase”. Applicant’s Brief at 13. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 375518 (Fed. Cir. 2019).

Applicant argues broadly that their fictional book goods and the fictional book goods of the registrant are so distinctly different, occupying such vastly differing genres, that they are “not likely to be confused by the public nor is an overlapping segment of the public likely to encounter or be interested in girls’ oriented fiction and science fiction comic books.” Applicant’s Brief at 10. This argument is both unpersuasive and not supported by the record. Applicant’s argument regarding the audience for its goods is based solely on speculation. Despite the applicant’s assertion that “science fiction graphic novels and young girls’ novels are located and sold in different sections of bookstores” there is no indication that a consumer could not purchase, enjoy, or encounter both genres of books within the same hypothetical bookstore. Applicant’s Brief at 10. Thus, the applicant is improperly ascribing limitations to the parties’ goods absent any indication of these limitations actually appearing in the identification of goods. Moreover, applicant provides no evidence forming the basis of their

argument pertaining to differing trade channels, aside from speculative assertions, and as such, they misconstrue the standards for a likelihood of confusion determination. These arguments should be found unpersuasive.

CONCLUSION

Applicant's mark, THE BLACK DIAMOND SERIES, is confusingly similar to the registrant's mark, THE BLACK DIAMOND EFFECT. Because of the similarity of the marks and the relatedness of the goods, confusion as to the source of the identified goods is likely. Moreover, to the extent that there is any doubt regarding a likelihood of confusion determination, such doubt is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988). For the reasons stated above, it is respectfully requested that the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

/Sanjeev K. Vohra/

Trademark Examining Attorney

Law Office 110

571.272.5885 - Work

571.273.5885 - Fax

sanjeev.vohra@uspto.gov

Chris A. F. Pedersen

Managing Attorney

Law Office 110

571-272-9371

chris.pedersen@uspto.gov